

### C. REMARKS

This Reply is in response to the Office Action mailed on June 28, 2004 in which claims 1-7, 10-14, 17, 18 and 44-50 were rejected, and claims 8, 9, 15 and 16 were objected to. Claims 1-18 and 44-50 are presented by the Applicants for reconsideration and allowance.

#### I. REJECTION OF CLAIMS 1-7, 10-14, 17, 18 AND 44-50 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HAMADA ET AL. IN VIEW OF NAKANISHI ET AL. AND VINCENT ET AL.

Section 1 of the Office Action rejected claims 1-7, 10-14, 17, 18 and 44-50 under 35 U.S.C. § 103(a) as being unpatentable over Hamada et al. (U.S. Pat. No. 6,086,485) in view of Nakanishi et al. (U.S. Patent No. 6,086,485) and Vincent et al. (U.S. Pat. No. 6,592,468). Claims 1, 13 and 44 are independent claims. Claims 2-7 and 10-12 depend from independent claim 1, claims 14, 17 and 18 depend from independent claim 13 and claims 45-50 depend from independent claim 44.

Independent claims 1, 13 and 44 include the following limitations.

1. A golf club head comprising:

a front wall including a rearwardly sloped front strike side and a rear side, the rear side having an upper region and a lower region which are generally coplanar with respect to each other;

a sole portion rearwardly extending from the lower region of the rear side, the sole portion including an upwardly extending rear wall having a forwardly facing inner surface, the rear side and the sole portion defining a forwardly extending cavity, the lower region of the rear side of the front wall and the sole portion, including the rear wall, defining a non-through sole portion recess, the recess downwardly extending into the sole portion and interconnected with the cavity, *the recess being open in an upward direction and having variable rearward depth, the forwardly facing inner surface of the rear wall being substantially non-parallel, and rearwardly sloped with respect, to the lower region of the rear side of the front wall such that the rearward depth of recess is greatest at its upper open end;* and

a resilient insert assembly positioned in and substantially filling the recess, the insert assembly coupled to at least one of the sole portion and the lower region of the rear side, the upper region of the rear side being generally uncovered, the insert assembly being fabricated of at least one material, the material having a durometer of between 20 on a Shore A hardness scale and 75 on a Shore D hardness scale. (*emphasis added*).

13. A golf club head comprising:

a front wall including a rearwardly sloped front strike side and a rear side, the rear side having an upper region and a lower region which are generally coplanar with respect to each other;

a sole portion rearwardly extending from a lower region of the rear side, the sole portion having a lower surface that is substantially entirely continuous, the sole portion including an upwardly extending rear wall having a forwardly facing inner surface, the rear side and the sole portion defining a forwardly extending cavity, the lower region of the rear side of the front wall and the sole portion, including the rear wall, defining a recess, the recess interconnected with the cavity and downwardly extending into the sole portion, *the recess being open in an upward direction and having variable rearward depth, the forwardly facing inner surface of the rear wall being substantially non-parallel, and rearwardly sloped with respect, to the lower region of the rear side of the front wall such that the rearward depth of recess is greatest at its upper open end*;

a first insert; and

a second insert contacting the first insert, the first and second inserts positioned only in, and collectively substantially filling, the recess, at least one of the first and second inserts attached to at least one of the sole portion and the lower region of the rear side, the first and second inserts made of first and second elastomeric materials, respectively. (*emphasis added*).

44. A golf club head comprising:

a front wall including a rearwardly sloped front strike side and a rear side, the rear side having an upper region and a lower region which are generally coplanar with respect to each other, the lower region of the rear side being substantially parallel to the front strike side;

a sole portion rearwardly extending from the lower region of the rear side, the sole portion including an upwardly extending rear wall having a forwardly facing inner surface, the rear side defining a forwardly extending cavity, the lower region of the rear side of the front wall, the forwardly facing inner surface of the rear wall of the sole portion and the sole portion defining a non-through sole portion recess, the recess interconnected with the

cavity and being open only in an upward direction, *the forwardly facing inner surface of the rear wall being substantially non-parallel, and rearwardly sloped with respect, to the lower region of the rear side of the front wall*; and

a resilient insert assembly positioned in and substantially filling the recess, the insert assembly coupled to at least one of the sole portion and the lower region of the rear side, the upper region of the rear side being generally uncovered. (*emphasis added*).

In the Office Action dated June 28, 2004 (now the fifth such Office Action relating to the present application), the Examiner rejects claims 1-7, 10-14, 17, 18 and 44-50 under 35 U.S.C. § 103(a) by combining Hamada et al., Nakanishi et al. and Vincent et al. However, even after combining three references this rejection still fails to meet the requirements for a rejection based upon obviousness under 35 U.S.C. § 103(a).

To establish a *prima facie* case of obviousness, three basic criteria MUST be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) MUST teach or suggest ALL the claim limitations.

*In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (*emphasis added*); MPEP § 2143.

The Examiner has failed to meet at least the first and final requirements necessary to establish *prima facie* obviousness. Hamada et al., Nakanishi et al., and Vincent et al. are devoid of any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to establish all the limitations of claims 1, 13 and 44, especially those limitations emphasized above. In particular, Hamada et al., Nakanishi et al., and Vincent et al. do not teach, suggest or disclose a golf club head including a front wall, having a rear side with upper and lower regions, a sole portion and a resilient insert assembly, wherein the sole portion includes an upwardly extending rear wall having a forwardly facing inner surface, and the lower region of the rear side of the front wall and the sole portion, including the rear wall, define a non-through sole portion recess. Further, the downwardly

extending recess is open in an upward direction and has variable rearward depth. The forwardly facing inner surface of the rear wall is substantially non-parallel, and rearwardly sloped with respect, to the lower region of the rear side of the front wall, such that the rearward depth of recess is greatest at its upper open end. Also, with respect to claim 44, Hamada et al., Nakanishi et al., and Vincent et al. do not teach, suggest or disclose, alone or in combination, the lower region of the rear side of the front wall being parallel to the strike side of the front wall, and the forwardly facing inner surface of the rear wall being substantially non-parallel, and rearwardly sloped with respect to the lower region of the rear side of the front wall.

Still further, Hamada et al., Nakanishi et al., and Vincent et al. do not teach, suggest or disclose an insert assembly positioned in and substantially filling the insert wherein the insert is formed of at least one material having a durometer of between 20 on a Shore A hardness scale and 75 on a Shore D hardness scale.

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); MPEP § 2143.01. Here, not only do Hamada et al., Nakanishi et al., and Vincent et al. fail to teach, or disclose the limitations of claims 1, 13 and 44, but they also do not suggest such a combination. Further, “[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.” *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986); MPEP § 2141.01.

In contrast to limitations of claims 1, 13 and 44, Hamada et al. discloses various embodiments of iron golf club heads. In one of the embodiments, shown in Figure 4, the club head includes a face forming portion having a strike face, and a sole forming portion. The sole forming portion is provided with a hole that extends into the sole portion with an open upper end and a closed sole-side end. The hole is elongated with one side of the clubhead that

defines the hole being positioned parallel with the face and an opposite side of the club head that also defines the hole also being positioned parallel to the face. These two substantially parallel walls that define the hole also provide the hole with a rearward depth that is generally uniform, and therefore not greatest at the open end of the hole. Hamada et al. emphasizes placing the hole as close to the face as possible and away from the center of gravity of the club head. In order to maintain the hole away from the center of gravity of the head, Hamada et al. discloses the hole as being narrow with a small, generally uniform rearward depth formed by the two generally parallel walls of the club head. In another embodiment, Hamada et al. discloses a club head with a filling portion that is preferably filled with a metal, but can also be filled with a plastic having a specific gravity lower than titanium.

Hamada et al. does not disclose a resilient insert assembly. Hamada et al. also does not teach, suggest or disclose a golf club head having a recess open in an upward direction and having variable rearward depth, and a forwardly facing inner surface of a rear wall that is substantially non-parallel, and rearwardly sloped with respect, to a lower region of a rear side of a front wall such that the rearward depth of the recess is greatest at its upper open end.

In further contrast to the requirements of claims 1, 13 and 44, Nakanishi et al. discloses a golf club head having a shooting face, a sole face and a rise upwardly extending from the sole face. A recess is formed into the rear side of the shooting face. A fiber reinforcement is placed in the recess and a synthetic resin backup is placed in the recess covering the fiber reinforcement. The rise is forwardly sloped with respect to the shooting face and results in a rearward depth of the recess that is smallest at the upper open end of the recess. These characteristics of the club head of Nakanishi et al. are directly opposite to the limitations of claims 1, 13 and 44.

Also in contrast to the limitations of claims 1, 13 and 44 of the present invention, Vincent et al. discloses various embodiments of a golf club head including a body

having a front striking face and a perimeter having a heel, a toe, a sole and a hosel. The body also has a rear cavity wall that forms the upper back side of the striking face, which is substantially parallel to the striking face. The sole has a lower surface and a slot upwardly extending into the sole from the lower surface. In some embodiments the slot upwardly extends from the sole into the lower surface without going through the sole, and in others it extends entirely through the sole. Vincent et al. does not teach, suggest or disclose a clubhead with a non-through sole portion recess downwardly extending into the sole portion of the club head. Further, Vincent et al. also fails to teach, suggest or disclose a golf club head having a recess open in an upward direction and having variable rearward depth, and a forwardly facing inner surface of a rear wall that is substantially non-parallel, and rearwardly sloped with respect, to a lower region of a rear side of a front wall such that the rearward depth of the recess is greatest at its upper open end.

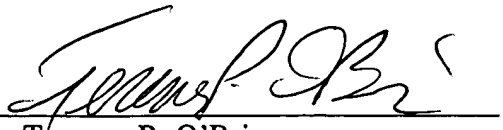
It is submitted that claims 1, 13 and 44 are patentable over Hamada et al. either alone, or in combination with, Nakanishi et al. and Vincent et al. because Hamada et al., Nakanishi et al., and Vincent et al. do not teach, suggest or disclose the combination of elements and limitations of either independent claims 1, 13 or 44, including at least the italicized limitations emphasized above in claims 1, 13 or 44. Additionally, Applicants submit that claims 2-7, 10-12, 14, 17, 18 and 45-50, which depend from independent claims 1, 13 and 44, are also patentable over Hamada et al., Nakanishi et al. and Vincent et al. for at least the same reasons.

## II. CONCLUSION

Applicants respectfully request reconsideration of claims 1-7, 10-14, 17, 18 and 44-50 for the reasons stated above. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration under 37 C.F.R. § 1.112 is respectfully requested. The Examiner is invited to telephone the undersigned at (773) 714-6498 to discuss any issues in this case in order to advance the prosecution thereof.

Respectfully submitted,

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